



07 FEB 2006

KENYON & KENYON LLP  
ONE BROADWAY  
NEW YORK NY 10004

In re Application of :  
VORBACH et al. :  
Application No.: 10/523,763 : DECISION  
PCT No.: PCT/EP03/08081 :  
Int. Filing Date: 23 July 2003 :  
Priority Date: 08 July 2002 :  
Attorney Docket No.: 02885/92 :  
For: METHOD AND DEVICE FOR PROCESSING :  
DATA :

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 22 November 2005 in the United States Patent and Trademark Office (USPTO). Petitioner's request for a two month extension of time is granted.

### **BACKGROUND**

On 07 February 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 28 July 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. The NOTIFICATION set a two-month extendable period for response.

On 22 November 2005, applicants filed the instant petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a declaration of inventors, the surcharge under 37 CFR 1.492(h), a statement of facts by Christian Schattenmann, a copy e-mails sent to nonsigning joint inventor and a request for a two month extension of time.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(g); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing

inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to item (1), the petition fee of \$200 under 27 CFR 1.17(g) has been paid. Thus, item (1) has been satisfied. Item (3) has been satisfied by providing the non-signing inventor's last known address.

With regard to Item (2), Petitioner submitted the Declaration of Christian Schattenmann, employee of assignee PACT XPP Technologies, AG. Mr. Schmattenmann indicates that he "mailed a copy of the present application and an unsigned declaration to Mr. Armin Nuckel" at his home address. Mr. Schmattenmann further states that "Mr. Nuckel received my letter, the application, and the declaration. Mr. Nuckel refuses to sign the declaration". Ms. Schattenmann indicates that the email confirms Mr. Nuckel's receipt and refusal. However, a copy of the letter mailed revealing the date of the mailing and the enclosures (specification, claims, drawings, if any, and the oath or declaration) was not provided. Nor was the evidence of delivery of the mailing. As for Mr. Nuckel's receipt and refusal to sign the above referenced application, it is not clear from the email that Mr. Nuckel received a copy of the complete application referred to as U.S. 10/523,763 as the email does not refer to either the PCT international application (PCT/EP03/08081) or the U.S. application.

As set forth in MPEP § 409.03(d), in pertinent part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. . . . It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

Proof that a bona fide attempt was made to present a copy of the application papers (specification, claims, drawings and oath or declaration) to the nonsigning inventor for signature is required. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. In the instant case, Mr. Schattenmann does not provide such documentary evidence in support of his statement. Petitioner has not yet established a refusal to sign.

Item (4) has been satisfied. The declaration filed 22 November 2005 is in compliance

with 37 CFR 1.497(a)-(b).

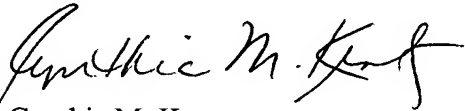
Items (2) is not been satisfied and thus, the petition under 37 CFR 1.47(a) is dismissed without prejudice.

### CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Cynthia M. Kratz  
Attorney Advisor  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (571) 272-3286  
Facsimile: (571) 273-0459